

## REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-16 and 22-31 are rejected under 35 U.S.C. 102(b) or under 35 U.S.C. 103(a) over the patent to Wainwright, et al.

The claims are also rejected under 35 U.S.C. 103(a) over the U.S. patent to Wainwright in view of the U.S. patent to Pirig.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended claims 1, 9 and 24, the broadest claims dealing with a method of painting a surface, a paint, and a method of producing a paint in accordance with the present invention, while claims 5, 13 and 28 have been canceled.

It is respectfully submitted that the new features of the present invention which are now defined in claims 1, 9 and 24 clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

Claims 1, 9 and 24 define a method of painting a surface, a paint, and a method of producing a paint, in which a paint is used having a

film-forming binder component, a color-producing component for providing a predetermined color, and a fire-retardant component adapted to protect a surface which is painted with the paint from consequences of fire and which does not exceed 15% of weight of the paint.

This feature of the present invention is new, unobvious, highly advantageous and critically important.

For the first time applicants proposed a paint which is provided with a fire-retardant component selected so that it efficiently achieves a fire retardation and at the same time provides the main function of the paint, namely providing a predetermined color of a surface on which the paint is applied, and these two functions are achieved so that required physical properties of the paint are maintained to its highest efficiency to achieve a reliable, fully covering, and efficiently coloring paint with fire retardant properties, without negatively effecting the painting results. The provision of the fire-retardant component, in addition to the film-forming binder component and the color-producing component, exclusively so that it does not exceed 15% of the weight of the paint provides for the above mentioned highly advantageous results.

Turning now to the references applied by the Examiner, and in particular to the patent to Wainwright, it can be seen that this reference relates to coating compositions, which in the Examiner's opinion are identical with paints. While applicants can not agree with the Examiner's opinion that these two different substances are completely identical, for the sake of argument, applicants are willing to show that the composition disclosed in the patent to Wainwright is completely different from the paint of the applicant's invention. As explained herein above, the paint of the applicant's invention provides efficient and sufficient painting with achieving a predetermined color and at the same time, fire retardation properties when the fire retardant component is taken with a content not more than 15% of the weight of the paint. Turning now to the Wainwright patent, it can be seen that, as shown for example in lines 51-59 of column 4, the components of the composition include ammonium polyphosphate 42 weight percent, melamine 18%, and pentaerythritol 15%, which makes total 75% of the composition. This preferred blend of the composition is miles away from the paint of the present invention in which the fire retardant component constitutes not more than 15% of the paint to maintain the properties of the product as the paint.

All other examples presented in this patent which deals with the composition disclosed in this reference, there is no hint or suggestion

that they can provide a paint which achieves the main functional painting results with a predetermined color and also fire retardant properties with the fire retardant component not exceeding 15% by weight of the paint.

It is believed to be clear that the paint to Wainwright does not disclose the new features of the present invention as now defined in claims 1, 9 and 24.

The Examiner rejected the claims as being anticipated over this reference under 35 U.S.C. 102. In connection with this rejection it is believed to be advisable to cite the decision in re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Wainwright does not teach each and every element of the present invention and therefore the anticipation rejection should be considered as not tenable and should be withdrawn.

The Examiner also rejected the claims over this reference under 35 U.S.C. 103 as obvious. The reference does not contain any hint or

suggestion that the present invention can be considered as obvious from it, and to the contrary teaches away from the present invention in view of significantly higher content of the fire-retardant component. In order to arrive at the present invention from the references as a matter of obviousness, the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention which are now defined in claims 1, 9 and 24. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

The Examiner further rejected the claims as obvious over the combination of the patents to Wainwright and Pirig.

The patent to Pirig deals exclusively with a flame-retardant coating which forms an insulating layer and is based on substances which

carbonize and form a foam layer in the event of a fire, on film-forming binders, on blowing agents and on customary auxiliaries and additives.

As clearly disclosed in this reference, this reference has nothing to do with paints or painting, but instead it deals exclusively with a flame-retardant coating. The patent to Pirig which discloses a flame-retardant coating gives many examples of its flame-retardant coating, but it never contains naturally any color-producing agent or pigment. There is no hint or suggestion why the patent to Wainwright which deals with a composition including a painting and allegedly, based on the Examiner's opinion can be considered as similar to a paint can be combined with an exclusively fire-retardant composition disclosed in the patent to Pirig. On the other hand, if for some unknown and highly improbable reasons the references were combined, when a recalculation is made to determine how much of a fire retardant component itself would be provided in the Wainwright composition taken from the Pirig fire-retardant composition, a combined hypothetical composition would not be identical to the applicant's invention.

The patent to Pirig taken alone does not teach the new features of the present invention as defined in claims 1, 9 and 24, the references can not be considered as combinable with one another, and a

hypothetical invention produced from such a combination would not be similar or identical to the present invention as defined in claims 1, 9 and 24. Claims 1, 9 and 24 should be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is further respectfully directed to the features of claims 7, 15 and 30 which define that the fire retardant component includes melamine, pentaerythritol and melamine polyphosphate with corresponding contents of these components in the fire retardant component which does not exceed 15% by weight of paint. The Examiner indicated that Pirig, et al equates melamine and ammonium polyphosphate. Pirig does not disclose the fire retardant component which includes melamine, pentaerythritol, and melamine polyphosphate with its corresponding contents in the fire retardant component of exceeding 15%. The fire retardant component in Pirig does not include all three components with its percentages. It has been found by the applicants that in particular these three components taken together with their ratio provide the highest fire retardant efficiency. The features of these dependent claims are not disclosed either to patent to Wainwright or the patent to Pirig, and definitely can not be produced from their combination.

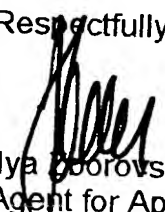
Therefore these dependent claims should also be considered as patentably distinguishing over the art and should also be allowed.

As for the other dependent claims, these claims depend on the independent claims, they share their allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

  
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Please extend  
the term for  
response by  
two months and  
charge to 26-0085